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09/025,395	02/18/1998	NILS R.C. RYDBECK	P-4015.100	9530

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COATS & BENNETT, PLLC  
P O BOX 5  
RALEIGH, NC 27602

EXAMINER

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/025,395	<b>Applicant(s)</b> RYDBECK ET AL.	
	<b>Examiner</b> Charles Appiah	<b>Art Unit</b> 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-18, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 20-23 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Examiner would like to draw Applicants' attention to the fact newly submitted (previously added) claims 20-23 are directed to an invention that is independent or distinct from the invention originally claimed and as such the withdrawal of the restriction requirement with regard to claims 1-10 does not include claims 20-23.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-23 are still withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-18, 24 and 25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

3. The indicated allowability of claims 6 and 7 is withdrawn in view of the newly discovered reference(s)- Kimura et al. (5,522,049) to overcome the indicated allowable subject matter. Rejections based on the newly cited reference(s) follow.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being over **Jackson** (U.S. Patent No. 6,516,466) in view of **Futami** (GB 2,308,775) and further in view of **Henriksson** (US 5,845,219).

Regarding claim 1, Jackson discloses a mobile radio communication device (portable digital cellular device 34) comprising a transceiver unit (36) for transmitting and receiving audio signals, and a speaker connected to the transceiver unit for converting audio signals received by the transceiver unit into audible signals which can be heard by a user. See Figures 3 and 4a, and col. 3, line 36 – col. 4, line 35. It is inherent that the device comprises a microphone connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver since the device uses voice recognition to request audio signals. The device also comprises memory (44) connected to the transceiver unit for storing pre-recorded audio for subsequent playback through the speaker.

Jackson fails to disclose when an incoming call is received during playback of the pre-recorded audio, playback stops.

In an analogous filed of endeavor, Futami discloses a portable telephone set and entertainment unit having a wireless headset and comprising: a transceiver (15) for transmitting and receiving audio signals, a speaker operatively (23) operatively connected to the transceiver unit for converting audio signals received by the

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transceiver unit into audible signals which can be heard by a user and a microphone (23) operatively connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver (see page 7, lines 1-17), a memory operatively connected to the transceiver (see page 6, lines 10-14, page 9, lines 8-15, page 14, lines 6-11). Futami discloses the capability of stopping the playback of the pre-recorded audio when an incoming call is received during a playback of a pre-recorded audio through a mode control unit (see page 7, line 18 to page 8, line 16, page 9, line 8 to page 10, line 23).

It would therefore have been obvious to one of ordinary skill in the art to combine Futami's teaching of changing over from music playback when an incoming call comes in order to notify and ensure that a user does not miss important calls while listening to music especially when used in crowded transportation facilities for example, as taught by Futami.

The combination of Jackson and Futami meet all limitations except the feature of having a screening memory in communication with the transceiver for string a list of preferred callers such that when an incoming call is received during playback of the pre-recorded audio, playback stops if the incoming call is from a caller on the list of preferred callers.

Henriksson discloses a method for storing at least one predetermined telephone number in a memory of a mobile station such that in response to an incoming call indication, a comparison is made between the calling party number and the stored numbers and if there is a match between the calling number and one of the

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stored numbers an audible alert is generated to inform the user of the presence of the incoming call and if there is no match, the generation of the audible alert is inhibited (see Figs. 3-4, col. 1, line 58 to col. 2, line 8, col. 4, line 23-50 and col. 5, lines 5-37).

It would therefore have been obvious to one of ordinary skill in the art to incorporate the feature of storing priority or preferred numbers for controlling incoming calls into Jackson as modified by Futami's portable telephone set in order to ensure the reception of important calls regardless of a user's location as taught by Henriksson (see col. 1, lines 40-47), while avoiding interrupting music playback unnecessarily.

Regarding claim 2, Jackson discloses all of the limitations of claim 1, and also discloses that the memory may be an erasable memory (such as RAM). See col. 3, lines 32-36 and 46-49.

Regarding claim 3, Jackson discloses all of the limitations of claim 1, and also discloses that the memory may be an unerasable memory (such as a PROM). See col. 3, lines 32-36 and 46-49.

Regarding claim 4, Jackson discloses all of the limitations of claim 1, and also discloses that the memory is contained in the transceiver unit (reading the whole device 34 as a transceiver unit). See Figure 3.

Regarding claim 8, Jackson discloses all of the limitations of claim 1, and also discloses that the device includes a headset, and that the speaker and microphone are mounted to the headset. See Figure 4a.

Regarding claim 9, Jackson discloses all of the limitations of claim 1, and also discloses that the device includes an input port (where the data bus 40 connects to the memory) for loading audio into the memory. See Figure 3.

6. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jackson** in view of **Futami** as applied to claim 1 above, and further in view of **Kimura et al. (5,522,049)**.

Jackson as modified by Futami fail to teach a removable battery pack or a detachable adapter attachable to the transceiver unit wherein the memory is located in the battery pack or adapter.

Kimura discloses a semiconductor disk device, which is capable of accepting a detachable IC card wherein a memory circuit and a battery are mounted in the IC card (see col. 4, lines 40-61). According to Kimura using the detachable IC card permits the memory capacity to be arbitrarily and freely changed and that the memory element of the card is not limited to static RAM but also an EEPROM, EPROM or mask ROM as other memory elements can be mounted resulting in an enlargement of use (see col. 5, line 14 to col. 6, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kimura's detachable or adaptable IC card having a memory and battery means with Jackson as modified by Futami in order to have the capability of changing a memory capacity as well using different memory elements and having high speed, high reliability and miniaturized external memory device that portably holds

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stored information, can be used with different terminals and have a large application range as taught by Kimura.

7. Claims 1, 11-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman (U.S. Patent No. 5,594,779)** in view of **Futami (GB 2,308,775)** and further in view of **Chin (U.S. Patent No. 5,661,788)**.

Regarding claim 1, Goodman discloses a mobile radio communication device comprising a transceiver unit (76/80/100) for transmitting and receiving audio signals, a speaker (62) connected to the transceiver unit for converting audio signals received by the transceiver unit into audible signals which can be heard by a user, a microphone (60) connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver, and a memory (82) connected to the transceiver unit for storing pre-recorded audio for subsequent playback through the speaker. See Figure 4 and col. 12, line 1 – col. 13, line 7.

Goodman fails to disclose when an incoming call is received during playback of the pre-recorded audio, playback stops.

In an analogous field of endeavor, Futami discloses a portable telephone set and entertainment unit having a wireless headset and comprising: a transceiver (15) for transmitting and receiving audio signals, a speaker operatively (23) operatively connected to the transceiver unit for converting audio signals received by the transceiver unit into audible signals which can be heard by a user and a microphone (23) operatively connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver (see page 7, lines 1-17), a memory



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operatively connected to the transceiver (see page 6, lines 10-14, page 9, lines 8-15, page 14, lines 6-11). Futami discloses the capability of stopping the playback of the pre-recorded audio when an incoming call is received during a playback of a pre-recorded audio through a mode control unit (see page 7, line 18 to page 8, line 16, page 9, line 8 to page 10, line 23).

It would therefore have been obvious to one of ordinary skill in the art to combine Futami's teaching of changing over from music playback when an incoming call comes in with Goodman's device order to notify and ensure that a user does not miss important calls while listening to music especially when used in crowded transportation facilities for example, as taught by Futami.

The combination of Jackson and Futami meet all limitations except the feature of having a screening memory in communication with the transceiver for string a list of preferred callers such that when an incoming call is received during playback of the pre-recorded audio, playback stops if the incoming call is from a caller on the list of preferred callers.

Chin discloses a system and method and system for selectively answering incoming telephone calls by enabling user to designate telephone numbers that he or she wants to receive calls from, as well as a selection of a notification mode for the incoming call reception (see title, abstract, col. 1, lines 50-67 and col. 3, lines 4-67).

It would therefore have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate Chin's selective answering of incoming calls

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feature based on designated and stored telephone numbers into Goodman as modified by Futami in order to avoid undesired incoming telephone calls.

Regarding claim 11, Goodman discloses a cellular telephone having an entertainment module for playing pre-recorded audio and video signals. The telephone comprises a transceiver (76/80/100) for transmitting and receiving audio and data signals, a microprocessor (68/104) for controlling the operation of the transceiver, a signal processing circuit (MAPOD decoder/encoder 84) connected to the transceiver and microprocessor for processing signals transmitted and received by the transceiver, and an entertainment module (MAPOD) with a computer memory (82) connected to the microprocessor (104) and signal processing circuits for storing audio and video signals for subsequent playback under the control of the microprocessor. See Figures 4 and 7, col. 12, line 1 – col. 13, line 7, and col. 14, line 63 – col. 16, line 33.

Goodman fails to disclose wherein the microprocessor stops playback of stored audio and video signals responsive to an incoming call such that a user may receive the incoming call free from playback of the audio and video signals.

In an analogous filed of endeavor, Futami discloses a portable telephone set and entertainment unit having a wireless headset and comprising: a transceiver (15) for transmitting and receiving audio signals, a speaker operatively (23) operatively connected to the transceiver unit for converting audio signals received by the transceiver unit into audible signals which can be heard by a user and a microphone (23) operatively connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver (see page 7, lines 1-17), a memory

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operatively connected to the transceiver (see page 6, lines 10-14, page 9, lines 8-15, page 14, lines 6-11). Futami discloses the capability of stopping the playback of the pre-recorded audio when an incoming call is received during a playback of a pre-recorded audio through a mode control unit (see page 7, line 18 to page 8, line 16, page 9, line 8 to page 10, line 23).

It would therefore have been obvious to one of ordinary skill in the art to combine Futami's teaching of changing over from music playback when an incoming call comes with Goodman's device in order to notify and ensure that a user does not miss important calls while listening to music especially when used in crowded transportation facilities for example, as taught by Futami.

The combination of Goodman and Futami meet all limitations except the feature of having a screening memory in communication with the microprocessor for storing a list of preferred callers such that when an incoming call is received from a preferred caller, the incoming call can be received free from playback of audio and video during playback of the pre-recorded audio, playback stops if the incoming call is from a caller on the list of preferred callers.

Chin discloses a system and method and system for selectively answering incoming telephone calls by enabling user to designate telephone numbers that he or she wants to receive calls from, as well as a selection of a notification mode for the incoming call reception (see title, abstract, col. 1, lines 50-67 and col. 3, lines 4-67).

It would therefore have been obvious to one of ordinary skill in the art, at the time the invention was made to incorporate Chin's selective answering of incoming calls

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feature based on designated and stored telephone numbers into Goodman as modified by Futami in order to avoid undesired incoming telephone calls.

Regarding claim 12, Goodman discloses all of the limitations of claim 11, and also discloses that the memory may comprises an erasable and programmable memory. See col. 15, lines 53-54.

Regarding claim 13, Goodman discloses all of the limitations of claim 12, and it is inherent that the telephone includes an input coupled to the erasable and programmable memory for downloading and storing the audio and video signals in to the erasable and programmable memory.

Regarding claim 18, Goodman discloses all of the limitations of claim 12, and also discloses that the microprocessor is pre-programmed to preempt output from the erasable and programmable memory in response to an incoming call or the initiation of an outgoing call. See col. 12, lines 12-25.

8. Claims 5 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman, Futami and Chin** in view of well-known prior art (Official Notice).

Regarding claim 14, Goodman as modified by Futami and Chin discloses all of the limitations of claim 11, but does not disclose that the memory comprises a permanent memory, which is removable from the cellular telephone for storing and playing audio and video signals. However, the examiner takes Official Notice that it is well known in the art to use removable permanent memory in a cellular telephone for storing data that the user may wish to use with devices other than the cellular telephone.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goodman as modified by Futami and Chin such that the memory comprises a permanent memory which is removable from the cellular telephone for storing and playing audio and video signals, so that a user may use the signals with other devices.

Regarding claim 15, Goodman discloses all of the limitations of claim 11 and also discloses that the entertainment module includes a first memory (picture RAM 135) which is programmable and erasable, an input coupled to the first memory for downloading and storing audio and video signals into the first memory, and a second memory (82) having pre-recorded audio and video signal stored therein. See Figures 4 and 7 and col. 16, lines 17-19. Goodman as modified by Futami and Chin do not disclose that the second memory is permanent.

However, the examiner takes Official Notice that it is well known in the art to use a permanent memory in a cellular telephone to store information that a user does not want erased. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goodman as modified by Futami and Chin, such that the second memory is a permanent memory, in order to prevent the pre-recorded audio and video signals from being erased.

Regarding claims 5 and 16, Goodman, Futami and Chin teach all of the limitations of claims 1 and 15. The combination of Goodman, Futami and Chin do not disclose that the second memory is a removable and interchangeable memory cartridge.

However, the examiner takes Official Notice that it is well known in the art to use interchangeable memory cartridges (such as smart cards) with cellular telephones to store information and use the information with other devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goodman, Futami and Chin such that the second memory is a removable and interchangeable memory cartridge, in order to use the audio and video signals with other devices.

Regarding claim 17, Goodman, Futami and Chin discloses all of the limitations of claim 12, but do not disclose that the erasable and programmable memory is coupled to a headset port in the cellular telephone, thereby permitting audio signals to be directed from the erasable and programmable memory to a headset coupled to the cellular telephone via the headset port. However, the examiner takes Official Notice that it is well known in the art to couple a headset to a cellular telephone for playing audio signals so that a user does not have to hold the telephone to his ear in order to hear the signals.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goodman such that the erasable and programmable memory is coupled to a headset port in the cellular telephone, thereby permitting audio signals to be directed from the erasable and programmable memory to a headset coupled to the cellular telephone via the headset port, in order to allow a user to listen to the audio signals without having to hold the telephone to his ear.

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9. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Goodman (5,594,779)** in view of **Kimura et al. (5,522,049)**.

Regarding claims 24 and 25, Goodman discloses a mobile radio communication device comprising a transceiver unit (76/80/100) for transmitting and receiving audio signals, a speaker (62) operatively connected to the transceiver unit for converting audio signals received by the transceiver unit into audible signals which can be heard by a user, a microphone (60) connected to the transceiver unit for converting the user's voice into audio signals for transmission by the transceiver, and a memory (82) operatively connected to the transceiver unit for storing pre-recorded audio for subsequent playback through the speaker. See Figure 4 and col. 12, line 1 to col. 13, line 7. Goodman fails to teach a removable battery pack or a detachable adapter for attaching to the transceiver unit wherein the memory is located in the battery pack or adapter.

Kimura discloses a semiconductor disk device, which is capable of accepting a detachable IC card wherein a memory circuit and a battery are mounted in the IC card (see col. 4, lines 40-61). According to Kimura using the detachable IC card permits the memory capacity to be arbitrarily and freely changed and that the memory element of the card is not limited to static RAM but also an EEPROM, EPROM or mask ROM as other memory elements can be mounted resulting in an enlargement of use (see col. 5, line 14 to col. 6, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kimura's detachable or adaptable IC card having a memory and

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battery means with Goodman's mobile audio program selection system in order to have the capability of changing a memory capacity as well using different memory elements and having high speed, high reliability and miniaturized external memory device that portably holds stored information, can be used with different terminals and have a large application range as taught by Kimura.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wingate (6,006,115) discloses wireless headphones for entertainment and telephonic communication.

Ma et al. (6,563,805) discloses a digital radio prepaid music-recording device.

Kim (6,681,120) discloses a mobile entertainment and communication device having a replaceable memory card for recording musical performances.

Kanamori et al. (6,662,022) discloses a portable telephone set capable of recognizing a call during music replay.

Partridge, III (5,473,671) discloses a system for selective screening of incoming calls in a cellular telephone.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone



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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**